

REMARKS

Claims 1-31 are pending in this application.

Claims 1-31 have been rejected.

No claims have been allowed.

Claims 2, 10, 12, 16, 19 and 25 have been amended.

Claims 1-31, as amended, remain pending in this application.

Reconsideration of Claims 1-31, as amended, is respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 112

The February 13, 2006 Office Action rejects Claims 1-4, 10, 12-14, 16, 19, 22 24-26 and 30-31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, the Applicant makes the following comments and amendments:

(1) With respect to Claim 1, the Examiner stated that the Examiner was unable to determine what the applicant is claiming by the claim language “a plurality of facilities in a complex” and “determining a cost associated with at least one of the facilities.” The Applicant respectfully traverses this assertion of the Examiner and respectfully submits that Claim 1 is not indefinite. The term “facility” and the term “complex” are clearly defined in the specification.

The term “facility” is defined on Page 7 of the specification. “In this specification, the term ‘facility’ refers to all or a portion of building, stadium, concert hall, amusement park, convention center, athletic center, transit system, or other structure or combination of structures.”

(Specification, Page 7, Lines 11-14). The term “complex” is also defined on Page 7 of the specification. “Also, in this specification, the term ‘complex’ refers to a collection of one or more facilities.” (Specification, Page 7, Lines 14-16). The specification goes on to give an example of a complex and its component facilities. “As an example, a church may represent a complex, and the auditorium, chapel, classrooms, gymnasium, and kitchen in the church may represent the facilities in the complex.” (Specification, Page 7, Lines 16-18).

Therefore, the expression “a plurality of facilities in a complex” is not indefinite. Because the term “facility” is not indefinite, the expression “determining a cost associated with at least one of the facilities” is also not indefinite. The Applicant respectfully requests the Examiner to withdraw the indefiniteness objections to Claim 1.

(2) With respect to Claim 1, the Examiner stated that the limitation “the identified potential revenue” has insufficient antecedent basis in Claim 1. The Applicant respectfully traverses this assertion of the Examiner and respectfully submits that Claim 1 is not indefinite. One of the elements of the method that is claimed in Claim 1 is “determining a potential revenue associated with at least one of the facilities.” The term “determining” and the term “potential revenue” provide sufficient antecedent basis for the term “the identified potential revenue.” Clearly, the determination of a potential revenue identifies the potential revenue. The Applicant respectfully requests the Examiner to withdraw this indefiniteness objection to Claim 1.

(3) With respect to Claims 2-4, 12, 16 and 25-26, the Examiner stated that the Examiner was unclear concerning the use of the expression “predicting a number of people who may use” at least one of the facilities. In response, the Applicant has amended Claims 2, 12, 16 and 25 to

change the expression to read “predicting a number of people who will use” at least one of the facilities. The Applicant respectfully submits that this amendment removes any indefiniteness from Claims 2-4, 12, 16 and 25-26. The Applicant respectfully requests the Examiner to withdraw the indefiniteness objections to Claims 2-4, 12, 16 and 25-26.

(4) With respect to Claim 10, the Examiner stated that the limitation “the changes” has insufficient antecedent basis in Claim 10. In response, the Applicant has amended Claim 10 to clarify that “changes” refers to changes in the altered data. The first step of Claim 10 (i.e., allowing a user to alter data used to generate the schedule) provides sufficient antecedent basis for the term “altered data.” The Applicant respectfully submits that this amendment removes any indefiniteness from Claim 10. The Applicant respectfully requests the Examiner to withdraw the indefiniteness objection to Claim 10.

(5) With respect to Claim 13 and Claim 30, the Examiner stated that the limitation “the identified cost” has insufficient antecedent basis in Claim 13 and in Claim 30. Claim 13 depends from Claim 1. Claim 1 contains the expression “the identified cost.” Therefore, Claim 13 has sufficient antecedent basis for the expression “the identified cost.” Claim 30 depends from Claim 24. Claim 24 contains the expression “the identified cost.” Therefore, Claim 30 has sufficient antecedent basis for the expression “the identified cost.” The Applicant respectfully requests the Examiner to withdraw the indefiniteness objections to Claim 13 and to Claim 30.

(6) With respect to Claim 14, the Examiner stated that the limitation “the identified cost” has insufficient antecedent basis in Claim 14. Claim 14 depends from Claim 1. Claim 1

contains the expression “the identified cost.” Therefore, Claim 14 has sufficient antecedent basis for the expression “the identified cost.”

(7) With respect to Claim 19 the Examiner stated that the limitation “the at least one change” has insufficient antecedent basis in Claim 19. In response, the Applicant has amended Claim 19 to clarify that “at least one change” refers to changes in the altered data. The first step of Claim 19 (i.e., allow a user to at least one of alter data used to generate the schedule and place a constraint on the data used to generate the schedule) provides sufficient antecedent basis for the term “altered data.” The Applicant respectfully submits that this amendment removes any indefiniteness from Claim 19. The Applicant respectfully requests the Examiner to withdraw the indefiniteness objection to Claim 19.

(8) With respect to Claim 22, the Examiner stated that the limitation “the identified cost” has insufficient antecedent basis in Claim 22. The Applicant respectfully traverses this assertion of the Examiner and respectfully submits that Claim 22 is not indefinite. One of the elements of the method that is claimed in Claim 22 is “determine a cost associated with at least one of the facilities.” The term “determine” and the term “cost” provide sufficient antecedent basis for the term “the identified cost.” Clearly, the determination of a cost identifies the cost. The Applicant respectfully requests the Examiner to withdraw this indefiniteness objection to Claim 22.

(9) With respect to Claim 24, the Examiner stated that the limitation “the identified potential revenue” and the limitation “the identified cost” have an insufficient antecedent basis in Claim 24. The Applicant respectfully traverses this assertion of the Examiner and respectfully

submits that Claim 24 is not indefinite. The elements of the method that is claimed in Claim 24 include “computer readable program code for determining a potential revenue associated with at least one of the facilities” and “computer readable program code for determining a cost associated with at least one of the facilities.” The term “determining” and the term “potential revenue” provide sufficient antecedent basis for the term “the identified potential revenue.” Clearly, the determination of a potential revenue identifies the potential revenue. Similarly, the term “determining” and the term “cost” provide sufficient antecedent basis for the term “the identified cost.” Clearly, the determination of a cost identifies the cost. The Applicant respectfully requests the Examiner to withdraw this indefiniteness objections to Claim 24.

(10) With respect to Claim 31, the Examiner stated that the limitation “the identified cost” has insufficient antecedent basis in Claim 31. Claim 31 depends from Claim 24. Claim 24 contains the expression “the identified cost.” Therefore, Claim 31 has sufficient antecedent basis for the expression “the identified cost.” The Applicant respectfully requests the Examiner to withdraw this indefiniteness objections to Claim 31.

II. REJECTIONS UNDER 35 U.S.C. § 103

The February 13, 2006 Office Action rejected Claims 1-2, 5, 13-15, 20-22, 24, and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,154,730 to Adams et al. (hereinafter “*Adams*”) in view of U.S. Patent Application Serial No. 2003/0233267 to Hertel-Szabadi (hereinafter “*Hertel*”).

The February 13, 2006 Office Action also rejected Claims 3-4, 8-9, 12, 16, 18 and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over *Adams* in view of *Hertel* and further in view of Christianitytoday.com.

The February 13, 2006 Office Action also rejected Claims 6-7, 10, 17 and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Adams* in view of *Hertel* and further in view of U. S. Patent No. 6,446,053 to Elliot (hereafter "*Elliot*").

The February 13, 2006 Office Action also rejected Claims 11, 19 and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Adams* in view of *Hertel* and Elliot and further in view of U. S. Patent No. 6,859,768 to Wakelam et al. (hereafter "*Wakelam*").

The Applicant respectfully traverses these rejections.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (*Fed. Cir.* 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir.* 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (*Fed. Cir.* 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir.* 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (*Fed. Cir.* 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443,

1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

The Applicant now directs the Examiner's attention to the unique and novel elements of Claim 1:

1. (Original) A method, comprising:
 - identifying a plurality of facilities in a complex, each facility associated with a construction project;
 - determining a potential revenue associated with at least one of the facilities;
 - determining a cost associated with at least one of the facilities; and
 - generating a schedule of the construction projects using the identified potential revenue and the identified cost. (Emphasis added).

The Examiner stated that "As for claims 1, 13-15, 20-21, and 30-31 Adams et al disclose a method, comprising: identifying a plurality of facilities in a complex, each facility associated

with a construction project (col. 1, lines 41-44; col. 3, lines 38-57)” (February 13, 2006 Office Action, Page 4, Lines 1-4). The Applicant respectfully traverses this assertion of the Examiner.

The cited portions of the *Adams* reference do not disclose the concept of “identifying a plurality of facilities in a complex, each facility associated with a construction project.” The *Adams* reference discloses a system for financing only one facility. The *Adams* reference states: “The present invention provides a system for financing a stadium facility to be constructed and/or operated by an originating entity and/or financing a team to play in such a facility.” (*Adams*, Column 1, Lines 41-44). Only one structure (i.e., a stadium facility) is mentioned that is to be constructed. A team to play in a facility is not a facility that is to be constructed. It is clear that the *Adams* reference does not disclose the concept of “identifying a plurality of facilities in a complex, each facility associated with a construction project.” Therefore, the *Adams* reference is a legally insufficient reference.

The portion of the *Adams* reference that is cited in Column 3, Lines 38-57 refers to allocating a portion of gate receipts to a special purpose fund to pay obligations to investors and allocating a portion of gate receipts to the operating needs of a sports team. There is nothing in this portion of the *Adams* reference that discloses the concept of “identifying a plurality of facilities in a complex, each facility associated with a construction project.”

The Applicant respectfully submits that the *Adams* reference does not teach an important element of the Applicant’s invention. The Applicant respectfully submits that the Applicant’s invention is not obvious in view of the *Adams* reference. Therefore, Claims 1-2, 5, 13-15, 20-22, 24, and 30-31 are not obvious in view of the *Adams* reference.

The Examiner stated that “Adams et al. do not disclose generating a schedule of the construction projects using the identified potential revenue and the identified cost.” The Applicant agrees that the *Adams* reference does not disclose “generating a schedule of the construction projects.” Indeed, the *Adams* reference does not even disclose construction projects (in the plural).

The Examiner suggests that the feature lacking in the *Adams* reference can be supplied by the *Hertel* reference. The Applicant respectfully traverses this assertion of the Examiner.

The *Hertel* reference discloses a project management method. *Hertel* states that a “project” may be thought of as “a collection of activities and tasks designed to achieve a specific goal. (*Hertel*, Page 1, Column 1, Paragraph [0004]). The *Hertel* reference is also silent concerning the concept of “identifying a plurality of facilities in a complex, each facility associated with a construction project.” There is simply no disclosure, suggestion or hint of using potential revenue and cost for each of a plurality of construction projects to generate a schedule for the construction projects, either in the *Adams* reference or in the *Hertel* reference, or in the two references in combination. This concept is only disclosed in the Applicant’s specification.

The Applicant respectfully submits that the deficiencies of the *Adams* reference are not supplied by the *Hertel* reference. Even if the *Adams* reference could be properly combined with the *Hertel* reference (which combination the Applicant respectfully denies is proper) the combination would still not disclose, teach or suggest all elements of Claims 1-2, 5, 13-15, 20-22 24, and 30-31.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) (“It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Rouffett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

The Applicant respectfully submits that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicant respectfully submits that the alleged motivation to combine

references is not clear and particular. The Examiner stated that “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Adams et al. to include the feature of [Hertel] in order to give to be able to give reasonable and reliable quotations.” (February 13, 2006 Office Action, Page 4, Lines 16-19). The Applicant respectfully traverses this assertion of the Examiner. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Applicant’s invention. Furthermore, the supposed motivation “to be able to give reasonable and reliable quotations” is too general and vague to provide legally sufficient motivation to combine the references.

Even if the *Adams* reference could somehow be combined with the *Hertel* reference, the combination would not teach, suggest, or even hint at the Applicant’s invention. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant’s disclosure. In the present case, the *Adams* reference and the *Hertel* reference in combination would not teach or suggest all the claim limitations of the Applicant’s invention.

With respect to independent Claim 15 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 1. Specifically, for the reasons

previously set forth, Claim 15 is not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination.

With respect to independent Claim 22 and independent Claim 24 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 1. Specifically, for the reasons previously set forth, neither Claim 22 nor Claim 24 is obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination.

For these reasons, the February 13, 2006 Office Action has not established a *prima facie* case of obviousness against Claims 1-2, 5, 13-15, 20-22 24, and 30-31 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of Claims 1-2, 5, 13-15, 20-22 24, and 30-31, as amended.

The February 13, 2006 Office Action also rejected Claims 3-4, 8-9, 12, 16, 18 and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over *Adams* in view of *Hertel* and further in view of Christianitytoday.com. Claims 3-4, 8-9 and 12 depend from Claim 1. With respect to dependent Claims 3-4, 8-9 and 12 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 1. Specifically, for the reasons previously set forth, Claims 3-4, 8-9 and 12 are not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The Christianitytoday.com reference does not supply the deficiencies that have been previously pointed out in the combination of the *Adams* reference and the *Hertel* reference.

Claims 16 and 18 depend from Claim 15. With respect to dependent Claims 16 and 18 the Applicant hereby reiterates and incorporates by reference the remarks previously made with

respect to Claim 15. Specifically, for the reasons previously set forth, Claims 16 and 18 are not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The Christianitytoday.com reference does not supply the deficiencies that have been previously pointed out in the combination of the *Adams* reference and the *Hertel* reference.

Claims 25-28 depend from Claim 24. With respect to dependent Claims 25-28 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 24. Specifically, for the reasons previously set forth, Claims 25-28 are not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The Christianitytoday.com reference does not supply the deficiencies that have been previously pointed out in the combination of the *Adams* reference and the *Hertel* reference.

The Applicant respectfully submits that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicant respectfully submits that the alleged motivation to combine references is not clear and particular. The Examiner stated that “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Adams et al. to include the feature of Christianitytoday.com in order to increase the user’s options for funding construction.” (February 13, 2006 Office Action, Page 5, Lines 32-35). The Applicant respectfully traverses this assertion of the Examiner. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the

existence of the Applicant's invention. Furthermore, the supposed motivation "to increase the user's options for funding construction" is too general and vague to provide legally sufficient motivation to combine the references.

Even if the Christianitytoday.com reference could somehow be combined with the combination of the *Adams* reference and the *Hertel* reference, the combination would not teach, suggest, or even hint at the Applicant's invention. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. In the present case, the combination of the Christianitytoday.com reference and the *Adams* reference and the *Hertel* reference would not teach or suggest all the claim limitations of the Applicant's invention.

For these reasons, the February 13, 2006 Office Action has not established a *prima facie* case of obviousness against Claims 3-4, 8-9, 12, 16, 18 and 25-28. Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of Claims 3-4, 8-9, 12, 16, 18 and 25-28.

The February 13, 2006 Office Action also rejected Claims 6-7, 10, 17 and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Adams* in view of *Hertel* and further in view of U. S. Patent No. 6,446,053 to Elliot (hereafter "*Elliot*").

Claims 6-7 and Claim 10 depend from Claim 1. With respect to dependent Claims 6-7 and Claim 10 the Applicant hereby reiterates and incorporates by reference the remarks

previously made with respect to Claim 1. Specifically, for the reasons previously set forth, Claims 6-7 and Claim 10 are not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The *Elliott* reference does not supply the deficiencies that have been previously pointed out in the combination of the *Adams* reference and the *Hertel* reference.

Claim 17 depends from Claim 15. With respect to dependent Claim 17 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 15. Specifically, for the reasons previously set forth, Claim 17 is not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The *Elliott* reference does not supply the deficiencies that have been previously pointed out in the combination of the *Adams* reference and the *Hertel* reference.

Claim 23 depends from Claim 22. With respect to dependent Claim 23 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 22. Specifically, for the reasons previously set forth, Claim 23 is not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The *Elliott* reference does not supply the deficiencies that have been previously pointed out in the combination of the *Adams* reference and the *Hertel* reference.

The Applicant respectfully submits that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicant respectfully submits that the alleged motivation to combine references is not clear and particular. The Examiner stated that “Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Adams et al. to include the feature of Elliott in order to provide the user with a cost associated with a phase of the construction.” (February 13, 2006 Office Action, Page 7, Lines 17-20). The Applicant respectfully traverses this assertion of the Examiner. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Applicant’s invention. Furthermore, the supposed motivation “to increase the user’s options for funding construction” is too general and vague to provide legally sufficient motivation to combine the references.

Even if the *Elliot* reference could somehow be combined with the combination of the *Adams* reference and the *Hertel* reference, the combination would not teach, suggest, or even hint at the Applicant’s invention. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant’s disclosure. In the present case, the combination of the *Elliot* reference and the *Adams* reference and the *Hertel* reference would not teach or suggest all the claim limitations of the Applicant’s invention.

For these reasons, the February 13, 2006 Office Action has not established a *prima facie* case of obviousness against Claims 6-7, 10, 17 and 23. Accordingly, the Applicant respectfully

requests withdrawal of the § 103 rejections and full allowance of Claims 6-7, 10, 17 and 23.

The February 13, 2006 Office Action also rejected Claims 11, 19 and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Adams* in view of *Hertel* and Elliot and further in view of U. S. Patent No. 6,859,768 to Wakelam et al. (hereafter "*Wakelam*").

Claim 11 depends from Claim 1. With respect to dependent Claim 11 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 1. Specifically, for the reasons previously set forth, Claim 11 is not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The *Wakelam* reference does not supply the deficiencies that have been previously pointed out in the combination of the *Adams* reference and the *Hertel* reference.

Claim 19 depends from Claim 15. With respect to dependent Claim 19 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 15. Specifically, for the reasons previously set forth, Claim 19 is not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The *Wakelam* reference does not supply the deficiencies that have been previously pointed out in the combination of the *Adams* reference and the *Hertel* reference.

Claim 29 depends from Claim 24. With respect to dependent Claim 29 the Applicant hereby reiterates and incorporates by reference the remarks previously made with respect to Claim 24. Specifically, for the reasons previously set forth, Claim 29 is not obvious in view of the *Adams* reference, or the *Hertel* reference, or the two references in combination. The *Wakelam* reference does not supply the deficiencies that have been previously pointed out in the

combination of the *Adams* reference and the *Hertel* reference.

The Applicant respectfully submits that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicant respectfully submits that the alleged motivation to combine references is not clear and particular. The Examiner stated that “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Adams et al. to include the feature of Wakelam et al. in order to provide the user to use what-if scenarios to get a variety of estimates.” (February 13, 2006 Office Action, Page 8, Lines 10-13). The Applicant respectfully traverses this assertion of the Examiner. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Applicant’s invention. Furthermore, the supposed motivation “to increase the user’s options for funding construction” is too general and vague to provide legally sufficient motivation to combine the references.

Even if the *Wakelam* reference could somehow be combined with the combination of the *Adams* reference and the *Hertel* reference, the combination would not teach, suggest, or even hint at the Applicant’s invention. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant’s

disclosure. In the present case, the combination of the *Wakelam* reference and the *Adams* reference and the *Hertel* reference would not teach or suggest all the claim limitations of the Applicant's invention.

For these reasons, the February 13, 2006 Office Action has not established a *prima facie* case of obviousness against Claims 11, 19 and 29. Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of Claims 11, 19 and 29.

III. CONCLUSION

For the reasons given above, the Applicant respectfully requests reconsideration and full allowance of all pending claims (Claims 1-31, as amended) and that this application be passed to issue.

The Applicant's attorney has made the amendments and arguments set forth above in order to place this Application in condition for allowance. In the alternative, the Applicant's attorney has made the amendments and arguments to properly frame the issues for appeal. In this Amendment, the Applicant makes no admission concerning any now moot rejection or objection, and affirmatively denies any position, statement or averment of the Examiner that was not specifically addressed herein.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.


The Applicant has included the appropriate fee to cover the cost of this AMENDMENT UNDER 37 C.F.R. § 1.111. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date:

May 15, 2006



William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *wmunck@munckbutrus.com*